



IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

MOIN et al.

Examiner: LAMBKIN, Deborah C.

Serial No.: 10/579,996

Group Art Unit: 1625

Filed: May 19, 2006

Title: BENZOFURANS AND BENZOTHIOPHENES

RESPONSE TO REQUIREMENT FOR A RESTRICTION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the requirement for Restriction mailed February 15, 2007, Applicants hereby elect Group III, claims 1-21 and 23-28, drawn to compounds, compositions, processes and methods of use of formula (I) wherein X is S and R1-R6 do not contain a heterocyclic ring.

In response to the requirement to elect a single species, Applicants hereby elect 2-(2-benzoylbenzo[*b*]thiophen-3-yloxy)-1-(4-chlorophenyl)-ethanone which is disclosed in the specification on page 18, line 6, and recited in claim 17 as the first compound. The requirement for restriction is respectfully traversed.

The requirement for restriction is respectfully traversed for a variety of reasons. First, inasmuch as the restriction is *within* a claim, it is submitted to violate the dictates of *In re Hass*, 486 F.2d 1053, 179 USPQ 623 (CCPA 1973) and *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978). It is submitted that, in accordance with MPEP § 806, the proper procedure is an election of

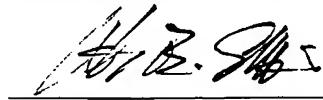
species. Inasmuch as the Office Action does, in fact, also request an election of species, it is submitted that the procedures set forth in the MPEP (examination of the elected species and such additional scope of the claim is necessary to determine patentability) should be the correct course, rather than *withdrawing* the non-elected *portions* of the claims.

Second, Applicants moreover respectfully disagree that the claims do not relate to a single general inventive concept. For example, the claims all have a single core constituting a proper Markush group, as amply discussed in, for example, *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980). The core is clearly constituted by the fused ring structure of formula (I), in claim 1. The fact that substituents on this ring may contain heterocyclic rings, and that the fused ring may contain an oxygen or sulfur atom, does not result in the core failing to be a proper Markush group. Indeed, in *Harnish*, not only could additional heterocyclic rings be present on the core structure, but the rings could be fused, and could contain heterocyclic atoms. The Federal Circuit's Predecessor Court unequivocally stated that such constituted a single core, and was "not repugnant to scientific classification." Accordingly, it is submitted that *Harnish* mandates that the present claims contain a special technical feature under the standards set forth in the Office Action.

Finally, it is submitted that little, if any, additional burden is incumbent upon the Examiner to examine the full scope of the claim.

Accordingly, withdrawal of the restriction requirement is respectfully requested.

Respectfully submitted,



Harry B. Shubin, Reg. No. 32,004
Attorney/Agent for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

Attorney Docket No.: MERCK-3167

Date: March 15, 2007

HBS:ske

K:\Merck\3000 - 3999\3167\3-14-07 Amendment to Restr. Req..doc